

**REMARKS**

Applicant respectfully requests reconsideration of this application in view of the foregoing amendments and the following remarks.

**A. Status of the Pending Claims and Explanation of Amendments**

Claims 1-11 are pending. The Examiner has rejected claims 1, 3, 4, 6-9, and 11. Claims 1 and 3 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 4,906,078 to Inabata (“Inabata”) in view of U.S. Patent No. 6,377,399 to Yanari (“Yanari”). Claims 1, 4, and 11 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,617,159 to Sakagami et al. (“Sakagami”) in view of U.S. Patent No. 6,377,305 to Onuki (“Onuki”). Furthermore, according to the subsection heading on page 4 of the Office Action, claims 1 and 6-9 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 2,985,071 to Becker (“Becker”) in view of Yanari and Inabata. However, Applicants note that, in the rejection of claims 1 and 6-9, the Office Action relies on Onuki for an “image inverting part” (see page 5 of the Office Action). Accordingly, it is Applicant’s understanding that claims 1 and 6-9 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Becker in view of Yanari, Inabata, *and* Onuki.

Additionally, the Examiner has objected to claims 2, 5, and 10 on the basis that these claims depend upon a rejected base claim. The Examiner has indicated that claims 2, 5, and 10 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims [see page 6 of the Office Action]. However, Applicant has not amended claims 2, 5, and 10 to be independent claims and respectfully assert that claim 1, from claims 2, 5, and 10 directly or indirectly depend, is patentable over the references cited in the

Office Action, for the reasons provided below. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the objection to claims 2, 5, and 10.

**B. The Combination of Inabata and Yanari Does Not  
Anticipate or Render Obvious the Claimed Invention**

The Examiner has rejected claims 1 and 3 under 35 U.S.C. §103(a) as allegedly being unpatentable over Inabata in view of Yanari. As set forth below in greater detail, Applicant respectfully traverses this rejection for at least the following reasons:

- (1) There is no motivation to combine Inabata and Yanari, and
- (2) Inabata teaches away from the combination proposed by the Examiner.

[see MPEP §§ 2143.01 and 2145].

1. **Inabata Teaches Away From the  
Modification Proposed by the Office Action.**

The Office Action states that

Yanari discloses an objective optical part which forms an image of an object (fig. 2, G1, G2, and G3), and has a first lens unit with a negative power (fig 1, G1) and a second lens unit with a positive power arranged from an object side in the order named (fig 1, G2), said second lens unit being capable of moving in a direction (fig 1); an image inverting part which converts an image formed by said objective optical part into an erect image (fig 1, P); and an eyepiece optical part which guides the erect image converted by said image inverting part to an observer (fig 1, EP) [Office Action, page 2].

However, based upon Applicant's review Yanari and Inabata, Applicant believes that there is a typographical error in the Office Action. Specifically, the figure citations in the Office Action excerpt quoted above are not from Yanari, but instead from Inabata. Accordingly, as best

understood by Applicant, the Examiner is relying on Inabata, not Yanari, for an objective optical piece, an image inverting part, and an eyepiece optical part. Furthermore, it is Applicant's understanding that the Examiner is relying on Yanari for "a second lens unit being capable of moving a component perpendicular to an optical axis to stabilize an image" [Office Action, page 2].

On the basis of this understanding, Applicant respectfully submits that Inabata teaches away from the Examiner's combination of the viewfinder recited by Inabata with the image stabilizing lens of Yanari. Inabata states that

the viewfinder according to the present invention is a real image viewfinder composed of an objective lens system  $G_1$  having positive refracting power as a whole an eyepiece lens system  $G_{II}$  having positive refractive power as a whole, said objective lens system  $G_1$  comprised, in order from the object side, a first lens unit  $G_1$  having negative refractive power, a second lens unit  $G_2$  having positive refractive power and a third lens unit  $G_3$  having positive refractive power. The variable magnification viewfinder according to the present invention has the composition described above, performs variation of magnification by shifting the second lens unit  $G_2$  toward the object side along the optical axis and simultaneously carries out adjustment of diopter by shifting the third lens unit  $G_3$  along the optical axis, thereby varying from the low magnification position to the high magnification position (emphasis added) [Inabata, col. 2, lines 5-23].

Applicant notes that Inabata expressly teaches that the operation of Inabata's viewfinder requires the second lens unit  $G_2$  and the third lens unit  $G_3$  to move along the optical axis. This is taught not only in the specification (col. 2, lines 5-23), but also in Figures 1-6 of Inabata, which clearly show that the lenses are moved along the optical axis. Furthermore, Applicant cannot find any teaching (express or otherwise) in Inabata that movement of lenses in other directions (*e.g.*, perpendicular to the optical axis, as suggested by the Office Action) would be an appropriate way to operate Inabata's viewfinder or is even possible with the viewfinder of Inabata.

Accordingly, Applicant asserts that Inabata does not lend itself to modification such as suggested by the Examiner because it expressly only discloses that the lenses are moveable along the optical axis.

Yanari is directed to an image stabilizing optical system having a “first lens group  $L_1$  [that] includes at least one positive lens and one negative lens” [Yanari, col. 3, lines 31-32]. The optical system also has a second lens group  $L_2$  that “is disposed to be movable in a direction perpendicular to an optical axis thereof, and is arranged to correct the position of the image by being decentered when the vibration occurs” [Yanari, col. 3, lines 32-35]. However, nowhere does Yanari teach, disclose, or suggest how one would insert the second lens group  $L_2$  into complex optical systems, such as those disclosed by Inabata, without affecting the performance of the optical system or changing its principle of operation. And more importantly, Yanari does not teach, disclose, or suggest how to select a lens from a plurality of lenses in a given complex optical system, such as that of Inabata, and make it function as an image stabilizing lens without affecting the performance of the optical system or changing its principle of operation. Accordingly, Applicant respectfully asserts that Yanari does not provide any motivation for combining lens group  $L_2$  with the optical system in Inabata’s viewfinder.

Applicant further notes that Yanari discloses that the second lens group ( $L_2$ ) has a negative refractive power, whereas Applicant’s claim 1 recites, inter alia, “a second lens unit with a positive power.” Applicant does not see any teaching (express or otherwise) in Yanari that the second lens unit could have a positive power as recited in Applicant’s claim 1.

For at least these reasons, there is no motivation shown to form the combination of Inabata and Yanari used to reject independent claim 1.

As the Examiner knows, many inventions are combinations of known (but theretofore uncombined) elements where the invention lies in recognition that those previously uncombined elements may be combined to produce a new and useful result. It is impermissible to use the claims of the application under examination as a roadmap to combine in piecemeal fashion elements arguably found in the prior art. [MPEP §2145].

Because of the incompatible teachings (vis-à-vis the proposed combination) of the cited reference and lack of motivation to combine them to form the combination proposed by the Examiner, Applicant submits that one of ordinary skill in the art would not be motivated to modify Inabata in view of Yanari in the manner proposed by the Office Action.

Accordingly, the rejection under §103 in view of the combination of Inabata and Yanari should be withdrawn.

**B. There is No Motivation to Combine Sakagami with Onuki**

Applicant respectfully traverses the rejection of claims 1, 4, and 11 under 35 U.S.C. §103(a) as being allegedly obvious over Sakagami in view of Onuki. Briefly, Applicant contends that there is no motivation to combine these references because, as a result of their combination, the camera of Sakagami would no longer function in its intended manner.

The Examiner states that

Sakagami et al. discloses an objective optical part which forms an image of an object (fig 1,2 ,3) [sic] and has a first lens unit with a negative power (fig 1,2) [sic] and a second lens unit with a positive power arranged from an object side in the order named (fig 1,3), said second lens unit being capable of moving in a direction including a component perpendicular to an optical axis to stabilize [sic] the image (col 5, line 65 to col 7, line 13) [sic].

The Examiner admits that Sakagami does not “specifically disclose an image inverting part which converts an image formed by said objective optical part into an erect image and an eyepiece optical part which guides the erect image converted by said imaging part to an observer” [Office Action at page 3].

For these elements, the Examiner relies on the pentagonal prism 142 and the eyepiece 143, as shown in Figure 1 of Onuki. The Examiner further alleges that

it would have been obvious to one skilled in the art...to use an image inverting part which converts an image formed by said objective part into an erect image and an eyepiece optical part which guides the erect image converted by said image inverting part to an observer as shown by Onuki, in the optical system of Sakagami et al., since as shown by Onuki, an image inverting part which converts an image formed by the objective optical part into an erect image and an eyepiece optical part are commonly used for guiding an erect image to the user of a camera for indicating the image that will be captured on film of the camera [Office Action, bridging paragraph between pages 3-4].

To the best of Applicant's understanding, the Examiner is attempting to insert the pentagonal prism 142 and eyepiece 143 of Onuki into Sakagami's camera. Applicants note, however, that Sakagami teaches that viewfinder 17 is a separate optical system that does not interact with the image recording optics or components, such as lens group 2 or compensation lens 3 of Sakagami's camera. Accordingly, Applicant contends that by simply inserting the pentagonal prism 142 and eyepiece 143 of Onuki into the camera of Sakagami, as proposed by the Examiner, the image coming from lenses 2 and 3 would be redirected to the eyepiece, and therefore would bypass the image recording medium disclosed by Sakagami. In other words, by making the proposed modification, the camera of Sakagami would no longer function in its intended manner.

If the Examiner decides to maintain this rejection, Applicant respectfully requests a clarification of how the camera of Sakagami would acquire images when combined with the pentagonal prism and eyepiece of Onuki, given that the pentagonal prism of Onuki would bend the light 90° from the optical axis defined by the lenses and image recording medium of Sakagami's camera.

Finally, Applicant does not see where in the Sakagami's specification there is a description of the power of focusing lens group 2 and compensation lens group 3. Accordingly, Applicant currently does not see where Sakagami discloses that a *positive* second lens unit behind the *negative* first lens unit is moved to perform image stabilization as stated in the Office Action. If this rejection of claims 1, 4, and 11 is maintained, Applicant respectfully requests clarification from the Examiner.

While Applicant has not explicitly addressed the individual rejections of the dependent claims, Applicant respectfully submits that the dependent claims which depend directly or indirectly from claim 1 are also patentable for at least similar reasons. Accordingly, they too are believed to be in condition for allowance. Reconsideration and withdrawal of the rejections of these claims under 35 U.S.C. §103(a) is respectfully requested. Applicant reserves the right to address those rejections, should such be necessary and/or appropriate.

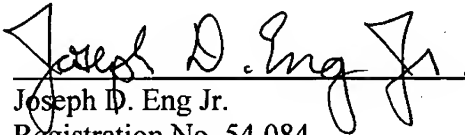
**CONCLUSIONS**

For at least the foregoing reasons, it is respectfully submitted that the pending claims are in condition for allowance. In the event that a telephone conference would facilitate examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

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